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OFFICE OF PETITIONS

In re Application of	:	
Yang et al.	:	
Application No. 10/784784	:	ON PETITION
Filing or 371(c) Date 02/24/2004	:	
Attorney Docket Number: SEC.1107	:	

This is a decision on the "Petition Under 37 C.F.R. §1.181 to Withdraw Improper Holding of Abandonment and in the Alternative Petition Under 37 C.F.R. §1.137(b) for Revival of an Application Abandoned Unintentionally," filed November 14, 2006.

This Petition under 37 CFR 1.181(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowability, mailed May 12, 2006. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned on August 13, 2006. A Notice of Abandonment was mailed September 20, 2006.

Petition under 37 CFR 1.181

Applicant files the present petition and states that the Notice of Allowability included an Examiner's Amendment wherein the Examiner sua sponte amended Figure 1 to add the label "PRIOR ART", and also added a new heading to Applicant's Specification. The Amendment, Applicant avers, was made without any prior approval by Applicants. Applicant notes that, in conjunction with the Amendment, the Examiner required corrected drawings. Applicant's paid the issue fee but did not file corrected drawings.

Applicant argues that the Examiner's attempt to Amend the application without approval by Applicant lacks any legal authority under the Statute, Rules, case law and is therefore of null effect. Applicant directs attention to the Notice of Allowance which states that if, on examination, it appears that the applicant is entitled to a patent under the law, a notice of

allowance will be sent to the applicant¹. Applicant argues that there is no authority in the statutes, PTO rules or case law for issuing a Notice of Allowance and requiring Applicant's to do anything other than pay the issue fee, or correct drawing objections under 37 CFR 1.85. Applicant avers that 37 CFR 1.85 is inapplicable.

Applicant also takes issue with the Examiner's Amendment adding a new heading above paragraph [0016] in the Specification entitled "Summary of Invention," in order to separate. Applicant asserts that this change is a substantive change made without Applicant's approval, and was made contrary to MPEP 1302.04. Applicant's provide a putative quote of MPEP 1302.04 as follows:

"No Examiner's amendment, whether formal or informal, may make substantive changes to the written portions of the specification, including the abstract, without first obtaining applicant's approval."

Applicant avers that the MPEP 1302.04 prohibits an Examiner's Amendment that makes substantive changes to the written portion of the specification...without obtaining applicant's approval.

Applicant avers that no approval was obtained or even sought. Applicant's, with the filing of this petition, strenuously object to what Applicant's refer to as a misappropriation of authority to attempt to characterize portions of the disclosure as "prior art" which have not been so explicitly identified as such by Applicants.

Applicant's avers that the drawing or specification included a substantive deficiency, [and] the appropriate course of action was to issue an *Ex Parte Quayle* action.

Applicable Law, Rules and MPEP

The applicable statute, 35 U.S.C. § 133, Time for Prosecuting Application, states

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the

¹ 35 U.S.C. § 151, Issue of patent, states

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

This Office issued a Notice of Allowability on May 12, 2006, which stated:

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

a) In the specification, page 3, above paragraph [0016], insert the heading "Summary Of The Invention" in order to separate what is admitted prior art and the applicant's invention.

b) In FIG. 1 of the drawing insert the words "PRIOR ART" below the page.

(Emphasis supplied).

Analysis

Applicant seeks to conflate the two notices: the Notice of Allowance and issue Fee Due, and the Notice of Allowability, into one action under 35 U.S.C. 151. Applicant is advised that the Notice of Allowability is an action under 35 U.S.C. 133. The actions are separate and distinct. *See, Brenner v. Ebbert*, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968).

The Notice of Allowability was mailed to Applicant in accordance with 35 U.S.C. § 133, wherein Applicant was given 90 days to prosecute the application. Applicant received the Notice of Allowance and Issue Fee Due and the Notice of Allowability; however, Applicants chose to respond only to the Notice of Allowance and Issue Fee Due. As Applicants stated, Applicant's "did not file any new drawings." Petition at p.2. Applicant's thus failed to prosecute the application. As required in the applicable statute, the application "shall" be regarded as abandoned.

Regarding the Examiner's Amendment, the MPEP 1302.04, Examiner's Amendments and Changes, states:

Except by formal examiner's amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See 37 CFR 1.121.)

The prohibition averred by Applicant, against substantive changes to the written portion of the specification, more correctly prohibits "corrections, erasures, or interlineations may be made in the body of written portions of the specification...."

Here, as stated by Applicant, the Examiner added a new heading. The Examiner made no change to the body of the written portion of the specification. Moreover, as previously stated, the Examiner expressly stated that “[s]hould the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312.”

The MPEP provides,

[w]here an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g., the applicant’s contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

MPEP 711.03(c).

Applicant admittedly filed no response to the Notice of Allowability. There is no dispute as to the status of the application. In accordance with 35 U.S.C. § 133, the application is abandoned. A petition to revive the application (and fee) is the appropriate course of action.

Regarding Applicant’s assertion, that the drawing or specification included a substantive deficiency, [and] the appropriate course of action was to issue an *Ex Parte Quayle* action, as Applicant’s stated, an *Ex Parte Quayle* action is issued to correct formal matters, as opposed to substantive matters.

Conclusion

The Examiner’s Amendment was issued as part of the Notice of Allowability under 35 U.S.C. 133, and was not contrary to the MPEP 1302.04. Applicant failed to file a complete and proper reply to the Notice. The case is properly held abandoned. *Accord*, 37 CFR 1.135.

The petition to withdraw the holding of abandonment is dismissed.

The petition to revive under 37 CFR 1.137(b)

The Examiner has approved the drawing.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a corrected drawing²; (2) the petition fee; and (3) a proper statement of unintentional delay.

² Applicant’s are advised that a complete and proper (including timely), reply to the Notice, as set forth in the Notice, must be corrected drawing(s).

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

This application is being referred to Publishing Division for processing into a patent.

A handwritten signature in black ink, appearing to read "Derek L. Woods".

Derek L. Woods
Attorney
Office of Petitions